Remarks

Applicants have canceled claims 2-12 and 24-27 without prejudice or disclaimer and added new claims 29-120. Further, Applicants have amended the specification to update the address of the ATCC and to insert section headings. Attached hereto is a marked-up version of the changes made by the current amendments, captioned "Version With Markings To Show Changes Made." The amendments are fully supported by the specification and claims as originally filed, and thus no new matter has been added. Originally filed claims 1, 13-23, and 28, and new claims 29-120 will be pending upon entry of these amendments.

I. Amendment of the Specification.

The specification has been amended to update the address of the ATCC and to insert section headings. More particularly, the address of the ATCC was updated on page 6, and section headings were added on pages 1, 4, and 6. These amendments are fully supported by the specification and claims as originally filed. Accordingly, no new matter has been added by way of amendment, and entry of the above amendments is respectfully solicited.

II. Amendment of the Claims.

Claims 2-12 and 24-27 have been canceled without prejudice or disclaimer in favor of new claims 29-120 in order to claim additional embodiments of the subject matter of the provisionally-elected group. New claims 29-120 find support in the claims as originally filed and throughout the specification. Specifically, support for new claims 29-120 is found, for example, at page 5, first paragraph; at page 10, last paragraph to page 12,

first paragraph, and at page 30, last paragraph to page 31, fourth paragraph. Accordingly, no new matter has been added by way of amendment, and entry of the above amendment is therefore respectfully solicited.

III. The Restriction Requirement.

Pursuant to Paper No. 12, mailed March 28, 2001, the Examiner has required an election under 35 U.S.C. §§ 121 and 372 of one of Groups 1-13. The Examiner contends that the inventions or groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In response, Applicants provisionally elect, *with traverse*, the invention of Group 3 represented by originally filed claim 14 and new claims 29-120, drawn to antibodies, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that claims 2-12 and 24-27 have been canceled without prejudice or disclaimer, and that new claims 29-120 are directed to subject matter falling within the ambit of Group 3 as cast by the Examiner.

With respect to the Examiner's division of the invention into thirteen groups and the reasons stated therefor, Applicants respectfully disagree and traverse. Applicants respectfully request that the restriction requirement be withdrawn or, at the very least, revised such that the claim of Group 5 (claim 16, drawn to antagonists) and the claims of Group 3 can be examined together. Applicants point out that the specification teaches at page 20, last paragraph, that "[a]n antibody may antagonize a G-protein chemokine receptor of the present invention". Thus, some embodiments of the subject matter of Group 3 (new claims 29-124) fall at least partially within Group 5 as defined by the

Examiner, as some of the antibodies of new claims 29-120 could function as inhibitors of the polypeptide of the present invention. Accordingly, Applicants submit that at least the claims of Group 3 and Group 5 are linked so as to form a single general inventive concept under PCT Rule 13.1, and thus should be examined together.

Further, Applicants respectfully disagree with the Examiner and assert that Groups 1 and 2 are also linked so as to form a single general inventive concept under PCT Rule 13.1, and thus should be examined together. MPEP Appendix AI (the PCT Administrative Instructions) explicitly recognizes that unity of invention exists between a protein and the DNA sequence encoding that protein:

> **Example 17**
> Claim 1: Protein X
> Claim 2: DNA sequence encoding protein X.
>
> Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

MPEP Appendix AI, at AI-36. *See also* MPEP § 1850 at 1800-49 (accepting the examples in Annex B of the Administrative Instructions as examples of unity of invention).

Indeed, the PTO recognized this during the International Search of the International Application, and included claims 1-13, 21-22, and 27 within Group 1, drawn to human G-protein chemokine receptor, the DNA encoding it, vector constructs, host cells and method of using the receptor. "The special technical feature is the disclosed protein and DNA sequences." International Search Report; *see also* PCT Article 27(1) ("No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations."). Thus, at the very least, unity of

invention exists between Groups 1 and 2 of the present invention, and those groups should be examined together.

Similarly, claims for use of a given product are permitted with claims to said product. (*see* MPEP § 1850 at 1800-47). During the International Search, the PTO as ISA determined that unity of invention existed between (a) claims 15 and 17 drawn to an agonist and a method of treatment thereby, and (b) claims 16 and 18 drawn to an antagonist and a method of treatment thereby, such that they should be examined together as Groups 3 and 4, respectively. Thus, present Group 4 should at least be examined with present Group 6, and present Group 5 should at least be examined with present Group 7. *See* PCT Article 27(1).

Accordingly, in view of MPEP § 1850, MPEP Appendix AI, PCT Article 27(1), and PCT Rule 13.1, Applicants submit that the instant restriction requirement does not comply with PCT Rule 13.1 regarding unity of invention. Applicants therefore respectfully request that the restriction requirement under §§ 121 and 372 be reconsidered and rewritten or withdrawn.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Entry of the above amendments is respectfully solicited. In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for in the Petition for an Extension of Time submitted concurrently herewith, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: September 27, 2001

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Enclosures

VIA HAND DELIVERY SEPTEMBER 27, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Li

Attorney Docket No.: PF218US

Application Serial No.: 09/101,518

Art Unit: 1646

Filed: January 11, 1996

Examiner: Pak, M.

Title: Human G-Protein Chemokine Receptor HSATU68

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

The paragraph spanning pages 6-7 has been rewritten as follows:

In accordance with another aspect of the present invention there are provided isolated polynucleotides encoding a mature polypeptide expressed by the human cDNA contained in ATCC Deposit No. 97334, deposited with the American Type Culture Collection, 10801 University Boulevard, Manassas, VA 20110-2209, USA ~~12301 Park Lawn Drive, Rockville, Maryland 20852, USA~~, on November 6, 1995. The deposited material is a cDNA insert, encoding a polypeptide of the present invention, cloned into a pBluescript SK(-) vector (Stratagene, La Jolla, CA), which will confer ampicillin resistance upon transformation.

In the Claims:

Claims 2-12 and 24-27 have been canceled without prejudice or disclaimer.

New claims 29-120 have been added.